

### III. REMARKS

Claims 1-20 are pending and are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Morioka et al., (U.S. Patent No. 6,611,728) in view of Shimono (U.S. Patent No. 6,308,293). Claim 1 was rejected under 35 USC 101 as allegedly being software per se. Applicant traverses these rejections for the reasons stated below. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the claims in a subsequent patent application that claims priority to the instant application.

Claim 1 has been amended to include a computing device. Accordingly, Applicant submits that claim 1 is not software per se, and that the 35 USC 101 rejection of claim 1 should be withdrawn. Claim 9 was also amended to include a computing device.

#### 1. The cited art fails to disclose *simulating then determining a set of features*

Applicant herein restates the argument previously made in the response submitted 1/5/09 that Shimono clearly fails to teach or suggest **first** “simulating the operation of the device using a simulation program” and **then** “determining a set of features in the device from the simulation that are potentially causing the failure,” as recited, e.g., in the method of claim 9. Instead, the cited passages of Shimono clearly teach the opposite, i.e., performing a simulation based on suspected fault sites in order to verify an estimation (see column 1, lines 46-50). 4-55776 “compares ... *a result of a simulation performed by assuming suspected fault sites* and a result of a comparison ... to verify whether or not an estimation [i.e., a designer’s guess] is correct. Accordingly the cited passage of Shimono runs a simulation using suspected fault sites. As such,

the suspected fault sites are known in Shimono before the simulation. Conversely, the claimed invention determines features that are potentially causing a failure as a result of running the simulation. For this reason alone, Applicant submits that independent claims 1, 9 and 15 are not obvious in view of the cited art.

## **2. The references to Shimono are improper**

In addition, Applicant herein restates the previous objection to the citation of the column 1, lines 38-65 references in which Shimono discusses two Japanese prior art publications, 1-244384 (Heisei I) and 4-55776 (Heisei II). The discussion of these third party references by Shimono is effectively hearsay, and without citing the references themselves, these references should not be considered as prima facie evidence of obviousness. As such, Applicant submits that the current rejection is improper since it does not rely on a cited reference, but instead relies on a vague discussion of un-cited references. Accordingly, Applicant submits that the rejection was improper.

In addition, Applicant previously requested that the Office provide a more explicit explanation of where or how *"inputted set of suspected faulty device features"* and the *"previously studied features"* are taught in Shimono. As noted, the Office's reference to Shimono points to several paragraphs that provides a vague description of Heisei I and Heisei II. While the Office is entitled to assume a broadest reasonable interpretation of the claim features, Applicant is requesting that the Office specifically point out what specific features in Heisei I and Heisei II correspond to the *"inputted set of suspected faulty device features"*, and the *"previously studied features"* of Applicant's claimed invention. It is Applicant's contention that

the Office is misinterpreting and misapplying the cited passages of Shimono, and even using a broad interpretation, the cited sections cannot logically teach claims 1, 9 or 15.

### **3. The cited art fails to teach or suggest *comparing* as claimed by Applicant**

Applicant further asserts that the cited combination fails to teach or suggest, *inter alia*, “a fault isolation system that cross-references an inputted set of suspected faulty device features with the previously studied features listed in the defect table *to generate a set of possible failures*, and then *compares the set of possible failures with a fault signature of an existing failure* in order to identify causes of the existing failure.” Nowhere does either of the cited references teach or suggest comparing a *set of possible failures with a fault signature of an existing failure* in which the set of possible failures is generating by cross-referencing suspected faulty device features with the previously studied features listed in the defect table. Applicant submits that independent claims 1, 9 and 15 are not obvious in view of the cited art.

Each of the claims not specifically discussed are believed allowable for the reasons stated herein as well for there own additional features.

If the Examiner believes that anything further is necessary to place the application in condition for allowance, the Examiner is requested to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael Hoffman", with a horizontal line extending to the right. The signature is flanked by two small diagonal marks, one on each side.

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Michael F. Hoffman  
Reg. No. 40,019

Dated: 2/5/09

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